REMARKS

In the Office Action, the Examiner noted that claims 1-20 are pending in the application, and that claims 1-20 are rejected. By this response, claims 1 and 18-20 are amended; and claims 2-17 continue unamended. In view of the above amendment and the following discussion, the Applicants submit that none of the claims now pending in the application are anticipated under the provisions of 35 U.S.C. §102 or obvious under the provisions of 35 U.S.C. §103. Thus, the Applicants believe that all of the claims are now in condition for allowance.

Objection To The Drawings

The Examiner objected to the drawings for failing to comply with 37 C.F.R. §1.84(p)(5). In response, the Applicants have provided replacement sheets. These amendments contained within the replacement sheets are fully supported by the application as originally filed and add no new matter. The Applicants submit that the drawings are now in compliance with 37 C.F.R. §§1.84(p)(5). Therefore, the Applicants request reconsideration and withdrawal of the objection to the drawings.

Objection To The Specification

The Examiner objected to the Specification because of mislabeling of the "input/output (I/O) devices." The Applicants have amended the Specification as indicated above. In addition, the Applicants have also provided amendments which correct typographical errors in the Specification. Each of the amendments to the Specification is fully supported by the application as originally filed and adds no new matter. Therefore, the Applicants request reconsideration and withdrawal of the objection to the Specification.

Rejections Under 35 U.S.C. §102

In the Office Action, the Examiner rejected claims 1, 5, 9, 10, 12 and 20, under 35 U.S.C. §102(e), as being anticipated by Bray (U.S. Patent No. 6,166,780, issued December 26, 2000) ("Bray"). The rejection is respectfully traversed.

Bray discloses a device for analyzing and filtering a closed caption signal. Bray strips words or phrases from the closed caption signal without affecting the video image signal. For example, Figure 1 and col. 3, lines 20-56 of Bray, indicate that a microprocessor intercepts

offensive words from the closed caption signal and transmits the adjusted closed captioned signal to an onscreen display ("OSD"). The adjusted OSD is then added to the video signal and transmitted downstream.

In contrast, the Applicants disclose a method and computer readable medium that resolve a conflict between two devices capable of interpreting the embedded portion of a television signal. The method and computer readable medium adjust an embedded portion of a television signal such that a downstream receiver does not change the video display in view of the adjusted embedded signal. Each of the Applicants' independent claims recited this feature. For example, the Applicants' claim 1 recites:

> "Method for adjusting an embedded portion of a television signal comprising:
> receiving the television signal having the embedded portion;
> detecting the embedded portion of the television signal; and
> adjusting the embedded portion, where a downstream receiver is prevented from processing the adjusted embedded portion." (Emphasis added).

Applicants' independent claim 20 recites:

> "A computer readable medium storing a software program that, when executed by a computer, causes the computer to perform a method comprising:
> receiving a television signal having an embedded portion;
> detecting said embedded portion of said television signal; and
> adjusting said embedded portion, where a downstream receiver is prevented from processing the adjusted embedded portion." (Emphasis added).

Specifically, the Applicants' invention receives a television signal having an embedded portion. Upon detection of the embedded portion, a processor adjusts the embedded portion so that a downstream receiver (e.g., a television receiver) is prevented from processing the adjusted embedded portion of the television signal. Thus, only one of the two devices interprets the embedded information. The television signal is then sent downstream to the television receiver.

In contrast, Bray does not prevent a downstream receiver from processing the embedded portion of the television signal. In fact Bray acts as an intermediary device which filters out unwanted closed caption material. Upon transmission downstream to a television receiver, the television receiver may still process the embedded portion of the television signal. Thus, Bray does not teach each and every element of the Applicants' invention.

At least for the reasons given above, independent claims 1 and 20 are not anticipated by Bray. Further, dependent claims 5, 9, 10, and 12 (which depend either directly or indirectly from

independent claim 1) are not anticipated by Bray at least for their dependency upon independent claim 1. As such, the Applicants request reconsideration and withdrawal of the 35 U.S.C §102(e) rejection of claims 1, 5, 9, 10, 12, and 20.

Rejections Under 35 U.S.C. 103(a)

The Examiner rejected claims 2-4, 8, 11, 13, 16, 17 and 19 under 35 U.S.C. §103(a) as being unpatentable over Bray; and claims 6, 7, and 18 under 35 U.S.C. §103(a) as being unpatentable over Bray in view of Bestler et al. (U.S. Patent No. 5,638,112 issued June 10, 1997) ("Bestler"). The rejection is respectfully traversed.

A. Claims 2-4, 8, 11, 13, 16, 17 and 19

The Examiner rejected claims 2-4, 8, 11, 13, 16, 17 and 19 under 35 U.S.C. §103(a) as being unpatentable over Bray. The rejection is respectfully traversed.

The arguments presented above with respect to Bray are applicable with respect to the instant rejection. As such, and for brevity those arguments are incorporated into this section and will not be repeated in as great a detail. In addition, Bray addresses a different problem than the problem addressed by the Applicants. Specifically, Bray removes unwanted closed caption material from a video signal before the television receiver displays the closed captioned material.

Applicants' claim 1 as presented above recites a method which prevents a television receiver from processing an adjusted embedded portion of the television signal. Likewise, Applicants' claim 19 recites a system which contains similar features. Specifically, Applicants' claim 19 recites:

> A system for preventing a conflict in displayed video among a plurality of receivers comprising:
>
> a first receiver for receiving the television signal and adjusting the embedded portion of the television signal; and
>
> a second receiver, coupled downstream from said first receiver, for decoding the embedded portion adjusted by said first receiver, where said second receiver is prevented from processing the adjusted embedded portion.

However, Bray's downstream receiver can still process the embedded portion (i.e., the adjusted closed captioned material) after Bray's device has filtered unwanted material. In this regard, the Applicants' invention **teaches away** from Bray.

The test under 35 U.S.C. §103 is not whether an improvement or a use set forth in a patent would have been obvious or non-obvious; rather, the test is whether the claimed invention, considered as a whole, would have been obvious. Jones v. Hardy, 110 U.S.P.Q. 1021, 1024 (Fed. Cir. 1984) (emphasis added). Moreover, the invention as a whole is not restricted to the specific subject matter claimed, but also embraces its properties and the problem it solves. In re Wright, 6 U.S.P.Q. 2d 1959, 1961 (Fed. Cir. 1988) (emphasis added).

The Applicants' invention teaches away from Bray and addresses a different problem than Bray. Thus, the Applicants submit that Bray does not render the Applicants' claims 1 and 19 obvious. Furthermore, claims 2-4, 8, 11, 13, 16, and 17 depend either directly or indirectly from independent claim 1 and recites similar features thereof. As such, and for at least the same reasons as discussed above, the Applicants submit that claims 2-4, 8, 11, 13, 16, and 17 are also not obvious and fully satisfied the requirements under 35 U.S.C. §103. Therefore, the Applicants respectfully request reconsideration and withdrawal of the obviousness rejection of these claims.

B. Claims 6, 7, and 18

The Examiner rejected claims 6, 7, and 18 under 35 U.S.C. §103(a) as being unpatentable over Bray in view of Bestler. The rejection is respectfully traversed.

The arguments presented above with respect to Bray are applicable with respect to the instant rejection. The addition of Bestler does not correct the shortcomings of Bray. For example, Bray disclosed a set-top box capable of receiving and processing both analog and digital television signals.

As indicated above, Applicants' claim 1 recites a method which prevents a television receiver from processing an adjusted embedded portion of the television signal. Likewise, Applicants' claim 18 recites:

> An apparatus for adjusting an embedded portion of a television signal comprising:
> a demodulator for demodulating a received television signal to a baseband television signal comprising an embedded portion; and
> a processor, coupled to said demodulator, for detecting and adjusting said embedded portion of said baseband television signal, where a downstream receiver is prevented from processing the adjusted embedded portion.

Applicants' claims 1 and 18 recite an embedded portion of a television signal which has been adjusted such that the adjusted signal is prevented from being processed by a downstream

receiver. Further, dependent claims 6 and 7 contain the features of their independent base claim (independent claim 1).

Bestler is silent with respect to the adjustment of an embedded portion of a television signal where the adjusted signal is prevented from being processed by a downstream receiver. Further, Bray addresses a different problem from the problem that Applicants' invention addresses. As such, the Applicants respectfully submit that neither Bray nor Bestler either individually or in any reasonable combination render the Applicants' invention obvious.

Moreover, the mere fact that a prior art structure could be modified to produce the claimed invention would not have made the modification obvious unless the prior art suggested the desirability of the modification. In re Fritch, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992); In re Gordon, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984).

As such, the Applicants submit that claims 6 and 7 (which depend upon nonobvious claim 1 and recite additional features therefor); and claim 18 are not obvious and fully satisfy the requirements under 35 U.S.C. §103. Therefore, the Applicants respectfully request reconsideration and withdrawal of the obviousness rejection.

ALLOWABLE SUBJECT MATTER

The Examiner has objected to claims 14 and 15 as being dependent upon a rejected base claim. The Examiner concludes that these claims would be allowable subject matter if rewritten in independent form to include all of the limitations of their base claim and any intervening claims.

The Applicants thank the Examiner for indicating allowable subject matter with respect to these claims. However, in view of the arguments set forth herein, the Applicants believe that independent claim 1 (and all intervening claims) is in allowable form and, as such, the dependant claims 14 and 15, as they stand, are therefore in allowable condition. Therefore, the Applicants respectfully request reconsideration and withdrawal of the objection to claims 14 and 15.

CONCLUSION

Thus, Applicants submit that none of the claims presently in the application are anticipated under the provisions of 35 U.S.C. § 102(e) or obvious under the provisions of 35 U.S.C. § 103(a). Consequently, the Applicants believe that all these claims are presently in

condition for allowance. Accordingly, both reconsideration of this application and its swift passage to issue are earnestly solicited.

If the Examiner believes that there are any unresolved issues requiring adverse final action in any of the claims now pending in the application, it is requested that the Examiner telephone Mr. Kin-Wah Tong at (732) 530-9404 so that appropriate arrangements can be made for resolving such issues as expeditiously as possible.

Respectfully submitted,

12/2/03

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